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# TRANSMITTAL FORM

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Total Number of Pages in This Submission

Application Number	10/599322; Int'l Appln. No.: PCT/IB05/50987
Filing Date	Int'l Filing Date: 2005-03-22
First Named Inventor	Barry Scheirer
Art Unit	
Examiner Name	
Attorney Docket Number	US040176US

## ENCLOSURES (Check all that apply)

<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Reply	<input checked="" type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Change of Correspondence Address	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	<input type="checkbox"/> Declaration
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	<input type="checkbox"/> Receipt Confirmation Postcard
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Reply to Missing Parts/ Incomplete Application	<input type="checkbox"/> Landscape Table on CD	
<input type="checkbox"/> <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53		
Remarks		
Customer No. 28159		

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name			
Signature			
Printed name	W. Brinton Yorks, Jr.		
Date	2 July 2007	Reg. No.	28923

## CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature			
Typed or printed name	Jill Peistrup	Date	3 July 2007

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of    Atty. Docket

Barry Scheirer et al.    US040176US

Serial No.: 10/599,322

Int'l Appln. No.: PCT/IB2005/050987

Int'l File Date: 03/22/2005

Title: INTERCAVITY PROBE WITH CONTINUOUS SHIELDING  
OF ACOUSTIC WINDOW

Commissioner for Patents  
P.O. Box 1450  
Arlington, VA 22313-1450

**RENEWED PETITION UNDER 37 CFR 1.47(a)**

Sir:

This submission is in response to the decision by the Office PCT Legal Administration of 18 May 2007, dismissing applicants' original petition on an inventor's refusal to sign the patent application, but allowing reconsideration of this renewed petition.

The dismissal objected to the secondhand knowledge of the efforts to reach the non-signing inventor. Accordingly the Declaration of Jill Peistrup, the individual who personally made those efforts, is enclosed to provide firsthand knowledge of these efforts. This Declaration is accompanied by the inventors declaration and application and the instruction letter for signing sent to Mr. Hornberger and the certified mail return receipt postcard received by Ms. Peistrup.

The dismissal also objected to the lack of a statement of the last known address of the nonsigning inventor. This address is stated in the second paragraph of the Peistrup Declaration.

It is respectfully requested that the Commissioner permit the filing of this application with a Declaration unsigned by one of the five co-inventors, Alan Hornberger, who refuses to sign the Declaration signed by his four co-inventors. The underlying facts are as follows.

1. When Mr. Hornberger began his employment with Echo Ultrasound in 1988 he executed an agreement in which he agreed to assign inventions made during his employment to the company. See paragraphs (a) and (b) of the attached EMPLOYEE INNOVATION AND PROPRIETARY INFORMATION AGREEMENT. Mr. Hornberger renewed this obligation when Echo Ultrasound became a part of Philips Electronics as shown in paragraph 3 of the enclosed "Employee Ethics and Intellectual Property Agreement."

2. On December 16, 2003 Mr. Hornberger left the employ of Philips as shown by the enclosed "Affirmation of Confidentiality Agreement." On February 20, 2004 Mr. Hornberger's co-inventors submitted an invention disclosure that led to the filing of the present application. This invention disclosure named Mr. Hornberger as a co-inventor based upon his contributions to the invention prior to his departure from Philips. A provisional application substantially identical to and the basis for the present application was filed on April 2, 2004 as serial number 60/559,388.

3. On September 6, 2006 my assistant sent Mr. Hornberger a copy of the Declaration for this and another application and asked him to sign and return them. A copy of this letter is enclosed. The return receipt postcard from this mailing, a copy of which is enclosed, shows that the Declaration was received at Mr. Hornberger's last known address on September 13, 2006. A signed Declaration has not been returned by Mr. Hornberger. If it is, the undersigned will promptly submit it in this application. In the meantime, it is respectfully requested that this application be allowed to proceed with the Declaration signed all of the co-inventors except for Mr. Hornberger.

4. Please charge Deposit Account no. 14-1270 for the petition fee required by 37 CFR §1.17(g).

Respectfully submitted,

*W. Brinton Yorks*

By: /W. Brinton Yorks, Jr./

W. Brinton Yorks, Jr.

Reg. No. 28,923

Philips Electronics  
22100 Bothell Everett Highway  
P.O. Box 3003  
Bothell, WA 98041-3003  
(425) 487-7152  
July 2, 2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re  
Application  
of:

Scheirer et al.

Art Unit:

Serial No.:

10/599,322

Atty.

Filed:

25 September 2006

Docket: US040176US  
Examiner:

Title:

INTRACAVITY PROBE WITH CONTINUOUS SHIELDING OF  
ACOUSTIC WINDOW

Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313

DECLARATION

Sir:

I declare the following statements to be true and correct.

On or about September 6, 2006, I assembled the packet of documents, copies of which are attached, to be sent to Alan Hornberger at RR2 Box 2685, McAlisterville, PA 17049, the last known address on file for Mr. Hornberger. Along with this packet of documents was a cover letter, dated September 6, 2006, containing instructions to sign the enclosed documents, which were a Declaration and Power of Attorney, copies of which are included in the attached documents.

The cover letter and packet of documents were mailed to Mr. Hornberger on September 7, 2006, via Certified Mail, as evidenced by the Certified Mail receipt with the U.S. Postal Receipt stamp, a copy of which is enclosed.

It is believed that the documents were received at Mr. Hornberger's address because of the signature on the Return Receipt, a copy of which is also enclosed.

I have received no documents from Mr. Hornberger.

Respectfully submitted,

By Jill Peistrup  
Jill Peistrup  
(425) 487-7306

## ECHO ULTRASOUND

P.O. Box 552  
Lewistown, PA 17044

## EMPLOYEE INNOVATION AND PROPRIETARY INFORMATION AGREEMENT

To be completed in triplicate. Distribution: original copy to Personnel for the employee's folder; second copy to the employee; and third copy to Department Head.

## TO ECHO ULTRASOUND:

In consideration of my employment by Echo Ultrasound and of the salary or wages paid to me, I agree:

- (a) to disclose and assign to the Company as its exclusive property, all inventions and technical or business innovations developed or conceived by me solely or jointly with others during the period of my employment, (1) that are along the lines of the businesses, work or investigations of the Company or its affiliates to which my employment relates or as to which I may receive information due to my employment, or (2) that result from or are suggested by any work which I may do for the Company or (3) that are otherwise made through the use of Company time, facilities or materials;
- (b) to execute all necessary papers and otherwise provide proper assistance (at the Company's expense), during and subsequent to my employment, to enable the Company to obtain for itself or its nominees, patents, copyrights, or other legal protection for such inventions or innovations in any and all countries;
- (c) to make and maintain for the Company adequate and current written records of all such inventions or innovations;
- (d) upon any termination of my employment to deliver to the Company promptly all items which belong to the Company or which by their nature are for the use of Company employees only, including, without limitation, all written and other materials which are of a confidential nature relating to the business of the Company or its affiliates;
- (e) not to use, publish or otherwise disclose (except as my Company duties may require), either during or subsequent to my employment, any confidential information or data of the Company or any information or data of others which the Company is obligated to maintain in confidence; and
- (f) not to disclose or utilize in my work with the Company any confidential information of others or any inventions

or innovations of my own which are not included within the scope of this agreement.

This agreement supersedes and replaces any existing agreement between the Company and me relating generally to the same subject matter. It may not be modified or terminated, in whole or part, except in writing signed by an authorized representative of the Company. Discharge of my undertakings in this agreement shall be an obligation of my executors, administrators, or other legal representatives or assigns.

I represent that, except as stated below, I have no agreements with or obligations to others in conflict with the foregoing.

---

(TYPE OR PRINT IN INK, USING FIRM PRESSURE)

Full Name ALAN G. HORNBERGER ECHO ULTRASOUND  
Social Security No. 161-52-3230 Lewistown, Pennsylvania

---

Lis J. Wagner  
Witness (The employee's  
immediate superior or other  
appropriate representative  
of the Company)

(Signed)

Alan G. Hornberger  
(Employee's signature - to  
include employee's first name  
in full.)

BENEFITS COORDINATOR  
Position

(Date)

12/5/88

Will P. Mank  
Countersigned - Company President

The following are the only agreements to which I am a party, which may be in conflict with the obligations undertaken above:

---

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## Employee Ethics and Intellectual Property Agreement

In consideration of my accepting or continuing work at Philips Electronics North America Corporation or any of its divisions, subsidiaries or affiliates, (which will individually and collectively be called "the company") during such time as may be mutually agreeable, and in consideration of the salary or wages paid to me, I agree:

1. Not to use, publish or otherwise disclose (except as my job requires) either during or after my employment, any secret or confidential (proprietary) information or data of the company or its customers or any other third party received by the company in confidence.
2. Upon the termination of my employment, to deliver promptly to the company all written and other materials that relate to the business of the company or its affiliates.
3. To disclose promptly and agree to assign, without further compensation, to the company or its nominee as its exclusive property, all those inventions, and technical or business innovations (including works of authorship) developed or conceived by me alone or with others, while I am employed which: (a) pertain to any line of the businesses, work or investigations of the company or affiliates, (b) pertain to any demonstrably anticipated business, research or development of the company or its affiliates, (c) are suggested by or result from work that I may do for the company, or (d) are aided by use of time, materials, facilities, patents, trade secrets, know-how, technology, confidential information, ideas, copyrights, trademarks, and service marks and any and all rights, applications and registrations relating to them of the company.
4. To make and maintain for the company adequate and current written records of such inventions.
5. To perform all reasonable acts (such as execution of all necessary papers) and otherwise provide proper assistance (at the company's expense) during and subsequent to my employment to enable the company to obtain for itself or its nominees patents, copyrights or other legal protection for such inventions or innovations in any and all countries.
6. Not to disclose or utilize in my work any proprietary information of others (including that of any prior employers) or any inventions or innovations of my own which are not included within the scope of this agreement.

I have read and understood the Philips Electronics North America Corporation "Working Together" book. In consideration of my continuing employment with the company, I agree to abide by the ethical and legal principles of the company as they are incorporated in this book. I understand that failure to do so may result in the termination of my employment.

This agreement supersedes and replaces any Employee Ethics and Intellectual Property Agreement previously executed by me. It may not be modified or terminated, in whole or in part, except in writing signed by an authorized representative of the company.

I certify that to the best of my knowledge and belief, I am not a party to any other agreement or subject to any conflict of interests that will interfere with my full compliance with this agreement, except as specifically identified below. I understand that this agreement does not constitute a contract of employment, either express or implied.

ALAN HORNBERGER

PRINT NAME

EMPLOYEE'S SIGNATURE

DATE

4-16-03

WITNESS (Company Representative)

DATE

4-16-03

I represent that the following are the only agreements, relationships and matters to which I have an interest that may conflict with the obligations I have undertaken above. I further agree to promptly notify my supervisor in writing of any change in this information.

If employed in any of the following states: California, Delaware, Illinois, Kansas, Minnesota, North Carolina, Utah or Washington, employees should also sign the relevant paragraph of the Employment Inventory Attachment on the back of this agreement.



## Affirmation of Confidentiality Agreement

Your termination does not end your continued obligations under the Employee Agreement you executed on the date that you were hired. These obligations include, without limitation, your agreement not to disclose or use (either directly or indirectly) any confidential information relating to the business of PHILIPS which was acquired by you from any source during your employment at PHILIPS. Such information includes (but is not limited to) know-how, formulae, trade secrets, designs, ideas, methods, processes and any other non-public information processes, future development, plans, strategies and operations, and business and financial data, including but not limited to customer lists, customer leads, price lists, discount structures, profits and product manuals.

In addition, you have continuing obligations to PHILIPS, as set forth in the Employee Agreement, with regard to ideas, discoveries and inventions, whether patentable or not, and other confidential information, made or conceived during your employment with PHILIPS.

If you have any questions concerning the nature or extent of your obligations under the aforementioned Employee Agreement, please call John Skrypak, Counsel, at (212) 536-0830.

ALAN G. HORNBERGER

Employee's Printed Name

Alan G. Hornberger

Employee's Signature

12-16-03

Date

Liz A. Kennedy

Witness



# PHILIPS

## Philips Intellectual Property & Standards

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September 6, 2006

VIA CERTIFIED MAIL  
RETURN RECEIPT REQUESTED

Alan Hornberger  
RR 2 Box 2685  
McAlisterville, PA 17049

Re: Ultrasonic Probe Volume Compensation System  
PH Ref No.: US040174  
Intracavity Probe With Continuous Shielding of Acoustic Window  
PH Ref No.: US040176  
Documents for Signature

Dear Mr. Hornberger:

Would you please sign and date the enclosed sets of documents and return them to me in the enclosed self-addressed, stamped envelope by September 18, 2006. With the packet, I've included a copy of the relevant patent applications and drawings as previously approved by you.

Please let Brint Yorks know if you come across any information relative to these applications, such as issued patents or published patent applications or articles, or public presentations.

Thank you, and please let me know if you have any questions.

Cordially,

A handwritten signature in cursive ink that appears to read "Jill Peistrup".

Jill Peistrup  
Sr. Paralegal  
[jill.peistrup@philips.com](mailto:jill.peistrup@philips.com)  
Tel: +1 425 487 7306  
Fax: +1 425 487 8135

Enclosures

DECLARATION AND POWER OF ATTORNEY  
FOR PATENT APPLICATION

As a below named inventor(s), I/we hereby declare that:  
My residence, post office address and citizenship are as stated below  
next to my name;

I believe I am the original, first and sole inventor (if only one name  
is listed below) or an original, first and joint inventor (if plural  
names are listed below) of the subject matter which is claimed and for  
which a patent is sought on the invention entitled

INTRACAVITY PROBE WITH CONTINUOUS SHIELDING OF ACOUSTIC WINDOW  
the specification of which (check one)

[ X ] is attached hereto

[ ] was filed on \_\_\_\_\_ as Application Serial No.  
\_\_\_\_\_.

I hereby state that I have reviewed and understand the contents of the  
above-identified specification, including the claims, as amended by  
any amendment referred to above.

I acknowledge the duty to disclose information which is material to  
the examination of this application in accordance with Title 37, Code  
of Federal Regulations, §1.56(a).

I hereby claim the benefit under Title 35, United States Code, §120 of  
any United States application(s) listed below and, insofar as the  
subject matter of each of the claims of this application is not  
disclosed in the prior United States application in the manner  
provided by the first paragraph of Title 35, United States Code, §112,  
I acknowledge the duty to disclose material information as defined in  
Title 37, Code of Federal Regulations, §1.56(a) which occurred between  
the filing date of the prior application and the national or PCT  
international filing date of this application:

60/559,388  
Application Serial No.

04/02/2004  
Filing Date

\_\_\_\_\_  
Status

I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith as well as to file equivalent patent applications in countries foreign to the United States including the filing of international patent applications in accordance with the Patent Cooperation Treaty: W. Brinton Yorks, Jr. (Reg. #28,923), Frederick J. McKinnon (Reg. #28,240), Jack E. Haken (Reg. #26902), and Michael E. Marion (Reg. #32,266).

Address all telephone calls to W. Brinton Yorks, Jr. at telephone no. (425) 487-7152.

Address all correspondence to W. Brinton Yorks, Jr., ATL Ultrasound, Inc., 22100 Bothell Everett Highway, P.O. Box 3003, Bothell, Washington 98041-3003.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Inventor's Signature:

Full Name of First Inventor:

Barry Scheirer

Date:

Citizenship: United States

Residence City: McAlisterville, PA

Post Office Address: P. O. Box 3003, Bothell, WA 98041-3003, USA

Inventor's Signature:

Full Name of Second Inventor:

Kevin Wickline

Date:

Citizenship: United States

Residence City: Yeagertown, PA

Post Office Address: P. O. Box 3003, Bothell, WA 98041-3003, USA

Inventor's Signature:

Full Name of Third Inventor:

David Becker

Date:

Citizenship: United States

Residence City: Lewistown, PA

Post Office Address: P. O. Box 3003, Bothell, WA 98041-3003, USA

Inventor's Signature:

Full Name of Fourth Inventor:

Jeffrey Hart

Date:

Citizenship: United States

Residence City: Reedsville, PA

Post Office Address: P. O. Box 3003, Bothell, WA 98041-3003, USA

Inventor's Signature:

Full Name of Fifth Inventor:

Alan Hornberger

Date:

Citizenship: United States

Residence City: McAlisterville, PA

Post Office Address: P. O. Box 3003, Bothell, WA 98041-3003, USA

Is your RETURN ADDRESS completed on the reverse side?

<b>SENDER:</b>	
■ Complete items 1 and/or 2 for additional services. ■ Complete items 3, 4a, and 4b. ■ Print your name and address on the reverse of this form so that we can return this card to you. ■ Attach this form to the front of the mailpiece, or on the back if space does not permit. ■ Write "Return Receipt Requested" on the mailpiece below the article number. ■ The Return Receipt will show to whom the article was delivered and the date delivered.	
3. Article Addressed to:  Alan Hornberger RR 2 Box 2685 McAlisterville, PA 17049	4a. Article Number 7099 3400 0014 5308 2841
	4b. Service Type <input type="checkbox"/> Registered <input checked="" type="checkbox"/> Certified <input type="checkbox"/> Express Mail <input type="checkbox"/> Insured <input type="checkbox"/> Return Receipt for Merchandise <input type="checkbox"/> COD
	7. Date of Delivery 9-13-06
5. Received By: (Print Name)	8. Addressee's Address (Only if requested and fee is paid)
6. Signature: (Addressee or Agent)  <i>X Tracy J. Hornberger</i>	

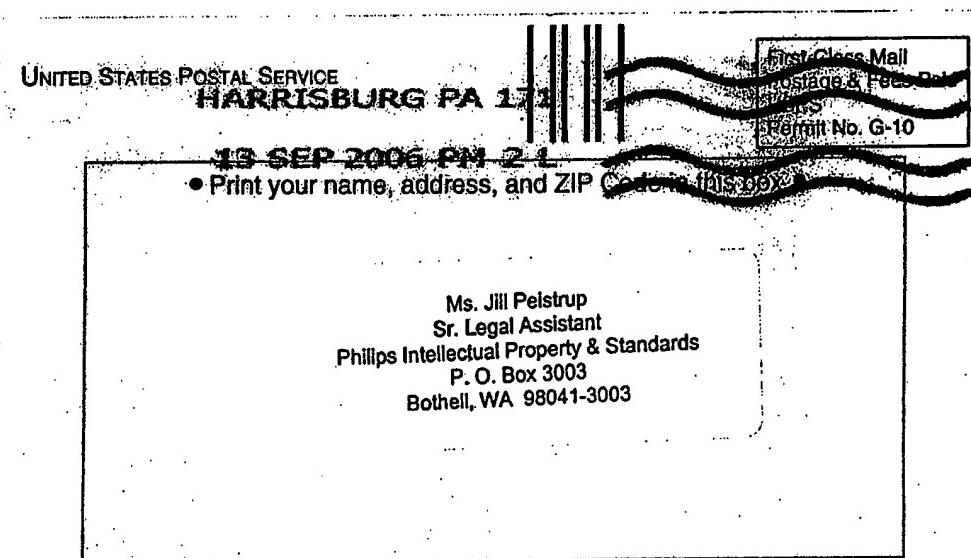
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102595-98-B-0229 Domestic Return Receipt

Thank you for using Return Receipt Service.

<b>U.S. Postal Service CERTIFIED MAIL RECEIPT (Domestic Mail Only; No Insurance Coverage Provided)</b>	
MC ALISTERVILLE PA 17049	
7099 3400 0014 5308 2841	Postage \$ 2.07 Certified Fee \$ 2.40 Return Receipt Fee (Endorsement Required) \$ 1.85 Restricted Delivery Fee (Endorsement Required) \$ 0.00 Total Postage & Fees \$ 6.32
Recipient's Name (Please Print Clearly) (to be completed by mailer) Alan Hornberger Street, Apt. No., or PO Box No. RR 2 Box 2685	
City, State, ZIP-4 McAlisterville, PA 17049	
PS Form 3800, February 2000      See Reverse for Instructions	

0210  
PAKISTAN  
SEP  
2006  
09/07/2006



**003-6500** **003-6500** **003-6500** **003-6500** **003-6500** **003-6500** **003-6500**